

REMARKS

In light of the above amendatory matter and remarks to follow, reconsideration and allowance of this application are respectfully solicited.

In the Office Action under reply, claims 1-8 were rejected under 35 USC 112, first paragraph, as allegedly “failing to comply with the enablement requirement.” The basis for this rejection was stated to be: “There is no structure set forth in the claims for the support member, the movable holding member, the guiding portions, and the guiding components” that are recited in the claims.

Claims 1-8 were rejected under 35 USC 112, second paragraph, for precisely the same reasoning.

No claim was rejected in view of prior art.

Reconsideration and withdrawal of these rejections are respectfully requested in light of the discussion below.

The Examiner is thanked for the courtesy of the telephone interview conducted May 12, 2009. During the interview Applicants’ representative discussed the amendment to claim 1 presented above. It is respectfully submitted, this amendment is sufficient to overcome the rejections based upon 35 USC 112. Nevertheless, Applicants’ representative makes the following arguments:

With respect to the rejection based upon 35 USC 112, first paragraph, it is respectfully submitted, the purpose of the specification to describe the claimed invention in sufficient terms that will enable one of ordinary skill in the art to make and use Applicants’ claimed invention.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention. 35 USC 112, first paragraph.

The Examiner has not objected to the specification on the ground that the specification fails to enable one of ordinary skill in the art to make and use the invention defined by the claims. Thus, as the Examiner correctly found, there is no question of lack of enablement -- the specification fully complies with the requirements of 35 USC 112, first paragraph.

It is the purpose of the claims to particularly point out the subject matter which the applicant regards as his invention:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. 35 USC 112, second paragraph.

Although Applicants' claims recite structure (claim 1, for example, previously recited, "support member," "movable holding member," "guiding portions" and "guiding components") it is apparent, the Examiner rejected the claims under 35 USC 112, second paragraph, because the structure that is described and shown in Applicants' specification and drawings are not recited in the claims. However, Applicants submit, there is no need to limit the claims solely to the illustrated embodiments, especially in the predictable field of technology to which the present invention relates. It is further submitted, Applicants' claims were clear and definite and were not ambiguous or vague. Indeed, the claims use the very same nomenclature as found in the specification, which not only is permitted, but preferred.

Applicants' representative refers to the following relevant portions of the MPEP:

MPEP §608.01(o) Basis for Claim Terminology in Description

"The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by

reference to the drawing, designating the part or parts therein to which the term applies” (emphasis added).

MPEP §2111 Claim Interpretation; Broadest Reasonable Interpretation

“The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1). *Phillips v. AWH Corp.*, 415 F.3d 1303, at 1316, 75 USPQ2d 1321 at 1329 (Fed. Cir. 2005)” (emphasis added).

“The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).”

MPEP §2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, “Written Description” Requirement

“An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).”

“While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.”

“... rejection of an original claim for lack of written description should be rare.”

“An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 (“drawings alone may provide a ‘written description’ of an invention as required by Sec. 112”); *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) (the drawings of applicant’s specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) (“In those instances where a visual representation

can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.").

"To comply with the written description requirement of 35 U.S.C. 112, para.1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure."

MPEP §2173.05(a) New Terminology

"The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed."

In the present application, the terms used in the claims are clear from the specification and drawings. Most of the terms used in the claim are identical to the terms used in the specification, which the Examiner has acknowledged provides a full and clear description of Applicants' invention. Claim 1 was amended previously to change the "structural member" to the "support member" to more accurately describe this member. While the specification describes this member 80 as a "structural" member, it is clear from at least paragraph [0064] of Applicants' corresponding published application that this member supports the holding member 90 so the latter is movable by disposing the holding plate 91 between the outside plate 70 and member 80. Hence, the expression "support member" is accurate and is fully described in the specification.

Therefore, it is seen that each and every element recited in Applicants' claims finds correspondence in Applicants' specification and drawings. In most cases, the very same terms used in the specification are used in the claims. Consistent with the foregoing portions of the MPEP, Applicants' claimed subject matter is fully supported by Applicants' specification; the specification and drawings describe Applicants' invention in sufficient detail to enable one of ordinary skill in the art to make and use that invention;¹ the meaning of every term used in

¹ Applicants' specification thus complies with 35 USC 112, first paragraph.


Applicants' claims is identified in the specification and drawings;² and Applicants' claims are clear and unambiguous and particularly point out the invention.³ Accordingly, there is no basis to reject claims 1-8 under 35 USC 112; and the withdrawal of the rejections of these claims is respectfully solicited.

Claims 1-8, as presented herein, are in condition for allowance; and early notice to that effect is respectfully requested.

Please charge any additional fees occasioned by this paper to our Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 
William S. Frommer
Reg. No. 25,506
Tel. (212) 588-0800

² Applicants' claims conform to MPEP §608.01(o).

³ Applicants' claims thus comply with 35 USC 112, second paragraph.